AF

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,483	09/23/2003	Takumi Kagawa	380-41	9078

23117 7590 12/06/2005

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER	
PERLINGER, SARAH E	
ART UNIT	**PAPER NUMBER**
1625	

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/667,483	KAGAWA ET AL.	
	Examiner	Art Unit	
	Sarah E. Perlinger	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09/23/2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-30* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8, drawn to optically active epoxyenone derivatives and to a process for producing optically active epoxyenone derivatives, classified in class 549, subclass 512.

II. Claims 9-11, drawn to optically active epoxyester derivatives, classified in class 549, subclass 517.

III. Claims 12-14 and 26-30 drawn to a process for producing an optically active epoxyester derivative, a process of producing an optically active (2S, 3R) –2,3-epoxypropionic acid derivative, and a process for producing an optically active 2,3-epoxy-3-cyclohexylpropionate and its ester, classified in class 549, subclass 539.

IV. Claims 15-24, drawn to a 3-halogenopropan-1-one derivative, classified in class 568, subclass 393 and a process for producing a 3-halogenopropan-1-one derivative, classified in class 568, subclass 312 .

V. Claim 25, drawn to a process for producing an α,β-unsaturated ketone derivative, classified in class 568, subclass 362.

The inventions of groups 1-5 are distinct, each from the other because:

Each group of claims is drawn to patentably distinct products or processes per se for making patentably distinct products. Each distinct product is not related to any other distinct product i.e. optically active epoxyenone derivatives are not related to a distinct compound such

as an optically active epoxyester derivative or to a distinct compound such as a 3-halogenopropan-1-one derivative. The search for any one individual group would not be coextensive or necessary for another group e.g. I-V for example the search for i.e. optically active epoxyenone derivatives of group I is not coextensive or necessary for the search of an optically active epoxyester derivative of group III. Each distinct process for making patentably distinct products is also not related to any other process for making patentably distinct products i.e. a process for producing optically active epoxyenone derivatives is not related to a process such as one for producing an optically active epoxyester derivative or a process for producing an optically active (2S, 3R) –2,3-epoxypropionic acid derivative. The search for any one individual group would not be coextensive or necessary for another group e.g. I-V i.e. a process for producing optically active epoxyenone derivatives of group I would not be coextensive or necessary for example for the search of a process for producing a 3-halogenopropan-1-one derivative of group IV. Such independent and distinct product or process must be examined separately.

Each distinct process for making patentably distinct products is not related to any distinct product. For example epoxides not derivative of an epoxyenone can still be oxidized using the process of group III yielding epoxy derivative products other than those of formula 3. Furthermore, optically active epoxyester derivatives of formula (3) can be synthesized by methods other than those of group IV such as the method described by Corey et al. ("An enantioselective synthesis of (2S,3S) - and (2R,3S)- 3 -hydroxyleucine", Tetrahedron Letters, 1992, page 6735). The search for any one individual group would not be coextensive or necessary for another group e.g. I-V i.e. the processes of group III for producing optically active

epoxyester derivatives would not be coextensive or necessary for example for the search of an epoxyester derivative product of group II. Such independent and distinct product or process must be examined separately.

Because these inventions are independent and distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent and distinct for the reasons given above and the search required for one group is not required for any other group, searching all the inventions would be burdensome, therefore restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Should applicant traverse on the ground that the groups are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the groups to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. In the instant case, then there would have been no patentability of all the claims over any of the claims because Watanabe et al. (*J. Org. Chem., 1998, 63, 8090)* in examples 10 and 12 on Table 1 anticipates claims 1-8 in group I.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah E. Perlinger whose telephone number is 571-272-5574. The examiner can normally be reached on 8:30 a.m.-5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/28/2005

DP

Celia Chang
Primary Examiner
Art Unit 1625